

Amendments to the Drawings:

The attached sheets of drawings include changes to Figs. 16-19. These sheets, which include only Figs. 16 -19, replace the original sheets including Figs. 16-19. In these figures, the legend "PRIOR ART" has been added.

Attachment: Replacement Sheets
Annotated Sheets Showing Changes

REMARKS

Fig. 16 has been amended to include the legend "PRIOR ART" in accordance with section 1 on page 2 of the Office action. Figs. 17-19 have been similarly amended, since they also show the prior art and in particular a problem that has vexed the industry for years.

Claim 3 has been canceled without prejudice or disclaimer, since the invention is adequately protected by the pending claims.

It is noted that the pending claims are 1 and 4-8, rather than 1 and 4-7. It appears that claim 8, which was added by preliminary amendment, has not been considered on the merits.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Horiki et al. (4,835,026). Claims 1, 3 and 4 (now 1 and 4) are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al. (5,206,069). Claim 3 (now canceled) is rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al. (4,835,026). Claims 1 and 3-7 (now 1 and 4-7) are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiki et al. (4,913,786).

The rejections are respectfully traversed. Except for claims 1 and 4, the examiner does not contend that the invention as defined by the claims is anticipated by any prior art; the rejections of claims 5-7 are all based on a conclusion of obviousness.

The claims have been amended by amendment of the independent claim to avoid the rejections. The claims as now pending are all directed to a masking member made of a foamed polystyrene having an expansion ratio in the range of between 5 and 100 times. Snapping grooves are formed at set positions on one or either side of the panel, dividing it into a plural number of unit blocks. In a case where the grooves are formed on one side of the panel, the depth of the grooves is set to be in the range of between 10 and

70% of the thickness of the panel, and in a case where the grooves are formed the sum of the depths of a pair of the grooves reciprocally at corresponding positions on either side of the panel, is set to be in the range of between 10 and 70% of the thickness of the panel. Moreover, the width of each groove is within the range of 0.1 to 5 mm.

The feature that the width of each groove is within the range of 0.1 to 5 mm is supported by the specification as originally filed. See page 4, line 8 from the bottom.

The invention as defined by the amended claims is neither disclosed nor suggested by the art relied upon. Horiki et al. '026, '069, and '786 all fail to disclose the width of the grooves, as noted in the Office action at page 4, second paragraph and last full paragraph, and page 5, second full paragraph.

The Office action notes that a change in size and/or shape is “generally” considered within ordinary skill in the art, citing MPEP 2144.04 IV. That implies a recognition that, depending on the facts of the case, a change in size and/or shape can have patentable significance. In order to distinguish cases where such a change is significant from those where it is not, we need to consider the relevant facts case by case.

The MPEP cites *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955), *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976), *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), and *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) as relevant to changes in size and/or shape. The present case is easily distinguished from those cases.

In re Rose is cited for the proposition that claims directed to a lumber package requiring handling by a lift truck are unpatentable over prior art lumber packages that could be lifted by hand. *In re Rose* thus relates to scaling up of a prior art process capable of being scaled up. *In re Rinehart* also relates to a mere scaling up.

In *Gardner v. TEC Systems*, the device having the claimed relative dimensions would not perform differently than the prior art device.

In *In re Dailey*, there was evidently no persuasive evidence that the particular configuration of the claimed container was significant.

Those cases state principles that can correctly be applied to cases with similar facts. But the facts of the present case are different in important respects.

When a coating of a part of a car or other manufactured item is to be applied by spraying, a prescribed number of unit blocks such as $2 \times 2 = 4$ blocks are first snapped from a large panel of blocks along preformed snapping grooves. The blocks thus removed are used as a mask to protect areas of the item that are adjacent to the area to be coated but need to be shielded from the spray.

It is convenient to provide masks in this way, because it is more economical to make a large panel than many small ones, and masks can easily be provided in a variety of sizes without having to inventory various sizes.

A problem of the prior art that remained unsolved for years prior to the present invention is that a mask made of blocks snapped from a conventional panel tends to have serrated edges. After the spray coating is applied and the blocks are removed, the edges of the coating are also serrated. Then, when a washer is applied to the area covered by the mask, there may be uncoated areas around the washer that are exposed to rust, etc. This is well explained on page 1 of the application and illustrated in Figs. 16-19.

The present invention solves this problem in a way that is novel and unobvious. In order to work, the grooves must be of a special design: if they are not deep enough, the snapping is too difficult; if they are too deep, the edges may be indented.

And not just the depth of the grooves is crucial; surprisingly, the width is also, as specified by the amended claims.

Finally, the optimum design is dependent on the material. The invention is directed specifically to a masking member made of foamed polystyrene having an expansion ratio in the range of between 5 and 100 times.

Clearly, the general language of the MPEP and of the cases cited there has no applicability to the facts of this application.

In contrast to *Rose* and *Rinehart*, the present application does not involve a scaling up of any prior art structure or process. It is not the scale that is critical, but the design, including the relation between the configuration of the masking member and the material of which it is made.

In contrast to *Gardner* and *Dailey*, a device having the claimed structure does perform differently than the prior art devices: the prior art devices produce serrated coating edges, causing exposure to the elements leading to rust, etc., whereas the present invention produces straight coating edges, preventing such exposure and rust. This is well documented by the specification, and the claims precisely define the structure that distinguishes the invention from the prior art. Since the prior art neither discloses nor suggests the invention as defined in the pending claims, the outstanding rejections should be withdrawn.

For the reasons, stated, issuance of a notice of allowance is respectfully requested.

Respectfully submitted,
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Fig.16
PRIOR ART ← added

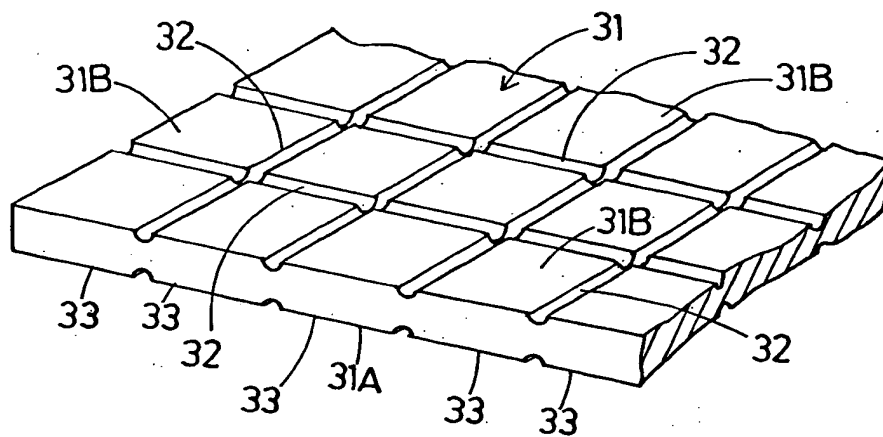


Fig.17
PRIOR ART ← added

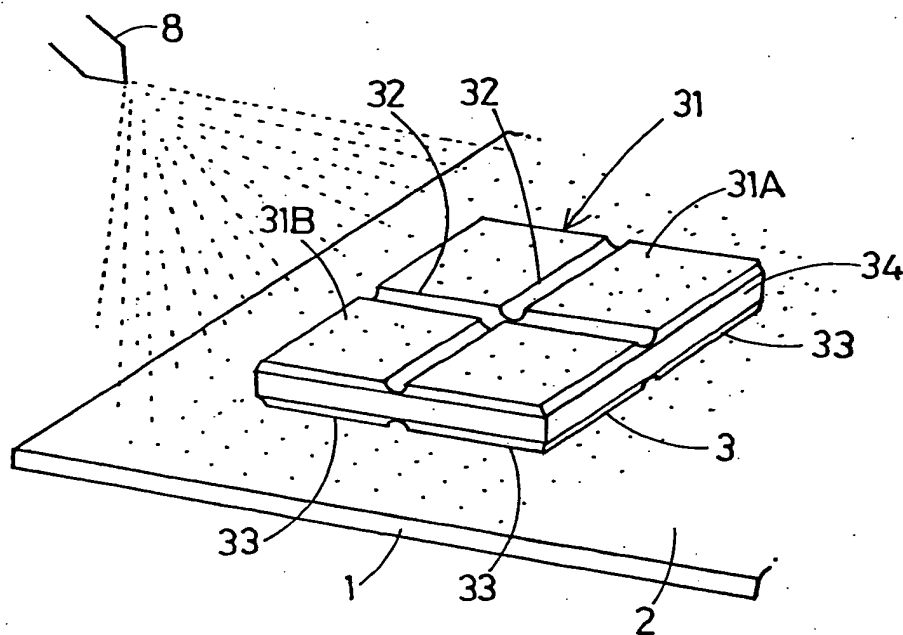


Fig. 18

PRIOR ART

added

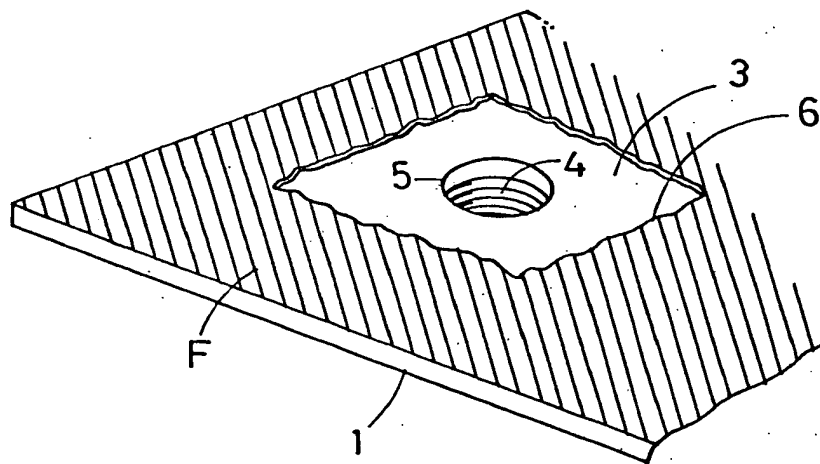


Fig. 19

PRIOR ART

added

